## REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

Claim 1 has been amended to incorporate the features of canceled claims 3 and 4. Claims 1, 2 and 5-9 are now pending in this application with claims 8 and 9 withdrawn from consideration as not readable on the elected invention.

Claims 1-7 were rejected under 35 U.S.C. §103(a) as unpatentable over JP 11-158305 "as evidenced by" U.S. Patent No. 6,284,828 to Takayama for reasons set forth in paragraph (2) of the Office Action. Reconsideration and withdrawal of this rejection are respectfully requested for at least the following reasons.

The presently claimed invention relates to a porous film molded from a composition comprising 25 to 55% by weight of a polyolefinic resin and 75 to 45% by weight of an inorganic filler, wherein the polyolefinic resin comprises 98 to 70% by weight of a linear low density polyethylene and 2 to 30% by weight of a branched low density polyethylene. The composition further contains 0.5 to 5 parts by weight of a liquid ethylene-α-olefin oligomer based on 100 parts by weight of the composition. The porous film obtained according to the invention has excellent moisture permeability ranging from 1500 to 4000 $g/m^2 \cdot 24$ hr. and a uniformness of thickness of 0.15 or less. High moisture permeability and a uniform thickness are important characteristics for porous films which are to be used in disposal diapers, water-proof building materials, reflective films, electric cell separators

and the like. The cited art does not disclose or suggest porous films as described in the present claims.

As acknowledged in the Office Action, JP '305 does not disclose or suggest polyolefinic porous films prepared from compositions containing a liquid ethylene/α-olefin oligomer. The Examiner relies on Takayama '828 for allegedly providing a teaching of using liquid ethylene/α-olefin oligomers. Respectfully, Applicants disagree for the following reasons.

Takayama '828 is not directed toward the preparation of porous polyolefin films. The main ingredient of the compositions disclosed therein is a polyacetal resin. Additional required components include a polyolefin, an alkylene glycol polymer and a filler. The addition of a lubricant is an optional feature. Several different classes of suitable lubricants are listed in columns 5-8 of the reference including silicones, α-olefin oligomers, paraffin, diphenyl ethers, fatty acid derivatives, and derivatives of aliphatic alcohols. Accordingly, Takayama '828 teaches the art that friction and abrasion resistance of compositions mainly composed of polyacetal resins can be improved by adding a modified polyolefin and an alkylene glycol polymer. Lubricants are optional but can be added for "enhanced effects" according to column 5, lines 29-31.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The motivation to modify the prior art references must flow from some teaching in the art that suggests the desirability or incentive to make the modifications needed to arrive at the claimed invention. In re Napier, 55 F.2d 610, 613; 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teachings, suggestion or incentive supporting the claimed combination. In re Geiger, 815 F.2d 686, 688; 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). As stated in In re Kotzab, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1316-17 (Fed. Cir. 2000),

> [m]ost if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant [citations omitted].

The objective of Takayama '828 was to improve the performance of molded articles prepared from polyacetal resin compositions. JP '305 is directed to a completely different technology, i.e. improving the properties of porous films prepared from polyolefin compositions. There would be no motivation or incentive to those of ordinary skill in the art seeking a solution to problems in the manufacture of porous polyolefin films, to look to the disclosure of Takayama '828 which is concerned with solving problems associated with improving friction and abrasion resistance of molded polyacetal resin compositions.

Assuming *arguendo*, that those of ordinary skill would seek to modify JP '305 in accordance with Takayama '828, Applicants point out that there is no disclosure in Takayama '828 which would lead one of ordinary skill to select liquid α-olefin oligomers as opposed to any of the other classes of lubricants disclosed therein. As a matter of fact, one of the preferred lubricants disclosed in Takayama '828, liquid paraffin (column 6, lines 7-10), is unsatisfactory for Applicants' purpose. Liquid paraffin was used in Comparative Example 6 of the present application and the porous film made therefrom had a uniformness of thickness above the maximum value set forth in the claims. Note Table 3 on page 24. Thus, there would be no reasonable expectation that substituting any of the lubricants disclosed in Takayama '828 for the alkylene bisamides used in JP '305 would be successful.

For at least the above reasons, the §103(a) rejection of the presently amended claims over JP '305 as evidenced by Takayama '828 should be withdrawn. Such action is respectfully requested.

Claims 1, 2 and 4-7 were rejected under 35 U.S.C. §103(a) as unpatentable over JP '305 in view of U.S. Patent No. 4,794,128 to Kawaguchi et al for the reasons expressed in paragraph (3) of the Office Action. Reconsideration of this rejection is requested for at least the following reasons.

Applicants reiterate the arguments presented in the last response that those of ordinary skill would not be motivated by the disclosure of the secondary reference to substitute a liquid α-olefin oligomer for the lubricants specified in JP '305. The reasoning

in support of Applicants' position is set forth on pages 3-4 of the Response filed May 21, 2003. Those of ordinary skill could not predict from the disclosure of the cited art that porous films prepared from the compositions set forth in the present claims would have outstanding moisture permeability and uniformness of thickness, among others.

Claims 3 and 4 were not rejected on this ground. The features of claims 3 and 4 have been added to claim 1 by the present amendment. Accordingly, the §103(a) rejection over JP '305 in view of Kawaguchi et al '128 should be withdrawn.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at his earliest convenience.

Respectfully submitted,

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Date: October 27, 2003

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